



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/659,046	06/03/96	BAUER	P 07807/006001

JOHN B. PEGRAM
FISH & RICHARDSON P.C.
45 ROCKEFELLER P.C.
NEW YORK NY 10111

C2M1/0717

EXAMINER	
DEXTER, C	
ART UNIT	PAPER NUMBER
3204	

DATE MAILED: 07/17/97

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/659,046

Applicant(s)
Bauer et al.

Examiner
Clark F. Dexter

Group Art Unit
3204



☒ Responsive to communication(s) filed on Mar 3, 1997

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-11 is/are pending in the application.

Of the above, claim(s) 1-5 and 8-11 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 6 and 7 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☒ The proposed drawing correction, filed on Mar 3, 1997 is ☒ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☒ received in Application No. (Series Code/Serial Number) 08/508,255.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Serial Number: 08/659,046

-2-

Art Unit: 3204

DETAILED ACTION

1. The amendment filed March 3, 1997 has been entered.

Oath/Declaration

2. The new declaration filed March 3, 1997 has been received and **approved**.

Drawings

3. The proposed drawing corrections filed on March 3, 1997 have been **approved**.

4. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification stands objected to under 35 U.S.C. § 112, first paragraph, as failing to provide an adequate written description of the invention.

As stated in the previous Office action, it is not clear from the disclosure how the pieces are being separated and thus it is not clear whether sufficient support is provided in the

Serial Number: 08/659,046

-3-

Art Unit: 3204

specification for the term "cutting" as set forth in the claims. It is not clear from the specification whether the portions of the plate are separated by cutting (i.e. shearing), tearing or breaking. Throughout the disclosure the term "cutting" is used to describe the separation. However, it is not clear how a cutting action which would completely cut through the plate is accomplished in any of the embodiments, particularly the schematic shown in Figures 1a-c. On page 4, beginning in line 17, it is described that relative rotation of more than 15° of the blocks will result in the plate 3 being cut. However, a relative rotation of a little more than 15° will result in only a partial shearing action. Further, as shown in Figure 1c, the respective blade pairs appear to remain spaced through the cutting action, and thus it is not clear how the portion in the immediate vicinity of the axis (4) is sheared. Clarification of the separating action is required.

Claim Rejections - 35 USC § 112

5. Claims 6 and 7 stand rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

Serial Number: 08/659,046

-4-

Art Unit: 3204

6. Claims 6 and 7 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 6, lines 8-9, the recitation that "said edges at the lower side ... directly touching said edges at the upper side" is unclear, appears to be inaccurate, and renders the limitation vague and indefinite, particularly since it is not clear how two opposing V-shaped cutting edges directly touch one another - rather, it seems that it is the upper and lower side which directly touch each other; in line 10, it seems that a comma --,-- is missing after "element"; in lines 12-13, the phrase "about the body" renders the limitation vague and indefinite since the tool is being defined in terms of the workpiece which is not part of the claimed invention.

In claim 7, line 2, it seems that a comma --,-- is missing after "slot"; in lines 3-4, "cutting edges" is vague and indefinite as to whether it is referring to the cutting edges previously described in claim 6 or the other such cutting edges; in line 6, it seems that a comma --,-- is missing after "center"; in line 7, structural cooperation is not positively provided for "handle", and it seems that --attached thereto-- or the like should be inserted after "handle".

Art Unit: 3204

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 6 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Stolpe.

Stolpe discloses a cutting apparatus (e.g. in Figure 2) with every structural limitation of the claimed invention including an upper shearing element (connected to e'), a lower element (connected to f'), and a means (e.g. b, l', l') for rotating the elements counter to one another.

9. Claims 6 and 7 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Schweitzer.

Schweitzer discloses a cutting apparatus with every structural limitation of the claimed invention including an upper shearing element in the form of a disc (78), a lower shearing element in the form of a disc (76), and means (including 10, 52, 54 and 28) for rotating the elements counter to one another, wherein each of the shearing elements has slot (96, 94) with a cutting edge which extends from the outer periphery toward the center and narrows toward the center, and a respective handle (88, 82) connected to each of the discs.

Art Unit: 3204

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

11. Claim 7 stands rejected under 35 U.S.C. § 103 as being unpatentable over Stolpe in view of Schweitzer.

Stolpe discloses a cutting apparatus (e.g. in Figure 2) with almost every structural limitation of the claimed invention including a handle (e',f') attached respectively to each shearing element but lacks each shearing element comprising a disc having a slot with a cutting edge extending from the outer periphery toward the center. Schweitzer discloses a cutting apparatus wherein the shearing elements each include a disc having a slot with a cutting edge as claimed wherein the slot narrows towards the center, and teaches that peripheral slots are provided for inserting lengths of rebar therein for cutting the rebar.

Serial Number: 08/659,046

-7-

Art Unit: 3204

Therefore, it would have been obvious to one having ordinary skill in the art to provide the discs of Schweitzer with slots therein on the cutting apparatus of Stolpe to gain the benefits taught by Schweitzer including that described above.

Response to Amendment

12. Applicant's arguments filed March 3, 1997 have been fully considered but they are not deemed to be persuasive.

In the last paragraph on page 3 and on page 4, applicant argues that the original disclosure is clear that the device cuts or shears the workpiece, and that the objection to the specification and the rejection of the claims under 35 USC 112, 1st paragraph, should be withdrawn. However, this issue remains unclear for the following reasons. On page 4, applicant discusses "torsional cutting" and "torsional separation" as the mode of operation for the present invention. Further, in the second paragraph on page 7 (and also at the bottom of page 7), applicant states that the body is twisted relative to the rest of the body to perform the "cutting" operation. However, these actions are not commensurate with the usual meaning of "cutting" or "shearing", wherein a sharp edge actually cuts through the workpiece (e.g., scissors cutting through paper, or shears cutting sheet metal). Rather, the action applicant appears to be describing is a tearing action or maybe a combination of a

Art Unit: 3204

shearing action and a tearing action. Thus, the operation of the device remains unclear.

In the third paragraph on page 6 of the amendment, applicant argues that the claims clarify that the device is a hand-held tool. It is noted that this distinction is described in the preamble and that no structure has been added to the body of the claim to distinguish this aspect of the present invention over the prior art.

In the fourth paragraph on page 6 of the amendment, applicant argues that the claims call for an application of a torsional shearing force about the longitudinal axis of the body being cut. However, as described in the above rejection under 35 USC 112, the limitation is vague and indefinite since the structure regarding the rotating of the elements is described in terms of the body which is the workpiece and is not part of the claimed invention.

In the second paragraph on page 7, applicant argues that Stolpe's device is designed and operated so as to force the knives into the workpiece, wherein the claims for the present invention call for an operation wherein a torsional force is applied causing a portion of the body to be twisted relative to the rest of the body. However, this is of little patentable moment since Stolpe discloses all of the claimed structure of the present invention as claimed. In particular, Stolpe's device

Serial Number: 08/659,046

-9-

Art Unit: 3204

comprises shearing elements with cutting edges, wherein the shearing elements are rotated while in contact with each other.

In the first paragraph on page 8, applicant argues that the difference between the present invention and Schweitzer is that the discs of Schweitzer rotate about axis 80 and not about an axis of the workpiece. However, as discussed above, the subject limitation is vague and indefinite since the structure regarding the rotating of the elements is described in terms of the body which is the workpiece and is not part of the claimed invention. There is nothing in the claims which distinguishes that structure of the present invention over that of the prior art.

Regarding the rejection under 35 USC 103, applicant argues that there is no suggestion to combine the references. However, as stated in the rejection, the discs of Schweitzer would be substituted into the device of Stolpe to provide peripheral slots for inserting lengths of rebar therein for cutting the rebar. It is noted that the test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in the pertinent art.

Serial Number: 08/659,046

-10-

Art Unit: 3204


Conclusion


13. Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1148.


RINALDI I. RADA
SUPERVISORY PATENT EXAMINER
GROUP 3200


C. Dexter
July 10, 1997